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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,875	02/16/2000	Toshikazu Nakajima	99USFP421-M.K.	5579

466 7590 03/26/2003

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EXAMINER

LEI, TSULEUN R

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/504,875

Applicant(s)

NAKAJIMA, TOSHIKAZU

Examiner

T. Richard Lei

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 8, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-22 and 25-27 is/are rejected.
- 7) ☒ Claim(s) 23, 24, 28 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's argument and amendments filed on January 8, 2003 have been fully considered, but they are not persuasive for the following reasons.

Applicant argues that the operation in the claims is based on the identity of the operated keys, and the Valimaa reference does not disclose that. The word "identity" can be interpreted broadly in that Valimaa teaches the use of dial keys, and not the soft keys, to change the operational mode of the cell phone. Since Valimaa determines the identity of the key as one of the dial keys, Valimaa reads on the claims in this application. Further, the claims do not exclude the use of the time duration of the key pressed, Valimaa reads on the claims.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 20-22 and 25-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Valimaa et al. (U.S. Patent 5,926,769).

Regarding Claim 20, Valimaa teaches a method of operating a portable telephone having plural numbered dialing keys for dialing a telephone number, the method comprising the steps of: establishing the telephone in a call origination mode; operating one of the plural numbered dialing keys and determining an identity of the operated one of the plural numbered dialing keys; and changing from the call origination mode to an operating mode in which a call cannot be originated based on the determined identity of the operated one of the plural numbered dialing keys (Fig.3).

Regarding Claim 21, Valimaa teaches the method of claim 20, wherein the operating mode in which a call cannot be originated is a stored telephone number search mode (Fig.3; Col.4, Lines 25-31).

Regarding Claim 22, Valimaa teaches the method of claim 20, wherein the step of changing from the call origination mode to an operating mode in which a call cannot be originated occurs when the determined identity of the operated one of the plural numbered dialing keys is one of a first set of the plural numbered dialing keys and wherein the step of changing from the call origination mode to an operating mode in which a call cannot be originated does not occur when the determined identity of the operated one of the plural numbered dialing keys is one of a second set of the plural numbered dialing keys that does not overlap the first set (Fig.3).

Regarding Claim 25, see Claim 20 for Valimaa's teaching.

Regarding Claim 26, see Claim 21 for Valimaa's teaching.

Regarding Claim 27, see Claim 22 for Valimaa's teaching.

Allowable Subject Matter

4. Claims 23 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 23 and 28 would be allowed if rewritten in independent form, because Valimaa does not teach the method of claims 22 and 27, wherein the second set includes keys for "0" and "1" and the first set includes two of the plural numbered dialing keys that are next to each other.

Claims 24 and 29 are objected to. But being dependent from Claims 23 and 28, Claims 24 and 29 would be allowed if Claims 23 and 28 are rewritten in independent form.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the

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mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. Richard Lei whose telephone number is 703-305-4828. The examiner can normally be reached on 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on 703-305-4778. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5403 for regular communications and 703-308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

TRL
TRL
March 20, 2003

THANH CONG LE
PRIMARY EXAMINER

3/21/03

TU2600